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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/812,712 | 03/19/2001 | Asutosh Nigam | 8500-0256 | 9717 |

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EXAMINER

FLETCHER III, WILLIAM P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1762

DATE MAILED: 06/13/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,712

Applicant(s)

NIGAM, ASUTOSH

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,12-14,21-40,47-55,63 and 64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,12-14,21-40,47-55,63 and 64 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Office Action

I. Receipt of Amendment

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The examiner acknowledges receipt of applicant's amendment, timely filed 24 March 2003, made of record in this file as paper no. 11.

II. Response to Amendment

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Applicant's amendment amended the title, specification, and claims 1, 3, 4, 7, 12 – 14, 27 – 29, 47, and 48; canceled non-elected claims 5, 15 – 20, 41 – 46, and 56 – 62; and added new claims 63 – 64.

Newly submitted claim 63 recites non-elected species of polymeric polybase (see paper no. 9). Since applicant received an action on the merits for the originally presented species of polymeric polybase (polyethyleneimine, elected without traverse in paper no. 8), the examiner constructively elects this species by original presentation for prosecution on the merits. Accordingly, the examiner withdraws claim 63 from consideration as being directed to a non-elected species. See 37 CFR 1.142(b) and MPEP § 821.03.

20

III. Rejections under 35 U.S.C. § 112, 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

5 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10 Claims 1 – 4, 6, 7, 12 – 14, 21 – 40, 47 – 55, and 64 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

15 With respect to claims 1 and 47, applicant amended these claims to recite: "...wherein the surface of the surface is selected from the group consisting of a light-emitting surface, a reflective surface, a glossy surface, a luminescent surface, and a combination thereof...". While the originally-filed disclosure provides support for each of the claimed surfaces individually, it does not provide literal support for a surface that is a combination of more than one of these surfaces.

20 With respect to claims 3 and 48, applicant amended these claims to recite: "...wherein the opaque coating composition on the substrate is cured or allowed to dry after being contacted with the recording liquid." In the Examples, applicant discloses drying the opaque coating composition before applying the recording liquid. Thereafter, applicant discloses drying the thus-printed sheet. The originally-filed disclosure does not literally support drying the opaque
25 coating composition *after* application of the recording liquid, which encompasses an

embodiment in which the opaque coating composition is not dried at all prior to application of the recording liquid.

With respect to claim 28, applicant amended this claim to recite: "...wherein the [opaque coating] composition is an image enhancing composition." The originally-filed disclosure does not literally support this new limitation: that the *opaque coating composition* is an image enhancing composition.

With respect to claim 29, applicant amended this claim to recite "...1 wt.% to approximately 40 wt.%...". At p. 17 of the specification, applicant discloses "...1 wt.% to 50 wt.%, preferably 1 wt.% to 25 wt.%, most preferably 1 wt.% to 15 wt.%...". Nowhere is the newly-claimed range explicitly disclosed.

IV. Form & Content of Application

Title

In view of applicant's amendment, the examiner withdraws the objection to the title under this heading in paper no. 9.

Specification

In view of applicant's amendment, the examiner withdraws the objection to the specification under this heading in paper no. 9.

Claims

In view of applicant's amendment, the examiner withdraws the objection to the claims set-forth in paper no. 9.

5 Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 depends from claim 3. Both claims recite that the opaque coating is dried, therefore claim 12 does not further limit claim 3.

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V. Rejections under 35 U.S.C. § 112, 2nd Paragraph

In view of applicant's amendment and arguments, the examiner withdraws the rejections under this heading in paper no. 9.

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VI. Rejections under 35 U.S.C. §§ 102/103

In view of applicant's arguments, the examiner withdraws the rejections under this heading in paper no. 9.

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VII. Rejections under 35 U.S.C. § 103

In view of applicant's arguments, the examiner withdraws the rejection under this heading in paper no. 9.

VIII. Response to Arguments

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The examiner fully considered applicant's arguments set-forth in paper no. 11. These arguments are persuasive.

With respect to the term "metallic-looking," the examiner concurs with applicant's assessment. A claim is not indefinite just because it is broad. Further, absent a definition of the
10 term in the specification, the term may be construed according to its broadest reasonable interpretation. Therefore, while the term "metallic-looking" may be redundant and broad, the term is not indefinite, the broadest reasonable interpretation including "any degree of metallic appearance" as posited by applicant. Accordingly, the examiner withdrew this rejection above.

With respect to Netsch and Ota, the examiner disagrees with applicant's interpretation of
15 claims 1 and 47, as amended. These claims require merely that the image be dry, not that the opaque coating composition be permanently transparent even when dry. Obviously, the images produced by both Netsch and Ota are dry at some point, including after the transparentizing solvent has evaporated. Nevertheless, applicant is quite correct in noting that neither Netsch and Ota teach or suggest an opaque coating agent comprising both a polymeric polyacid and a
20 polymeric polybase. Accordingly, the examiner withdrew the rejections based on these references above. Further, the prior art neither teaches nor suggests a process in which the opaque coating agent comprises a polymeric polyacid and a polymeric polybase.

IX. Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this
5 Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
MONTHS of the mailing date of this final action and the advisory action is not mailed until after
10 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
however, will the statutory period for reply expire later than SIX MONTHS from the date of this
final action.

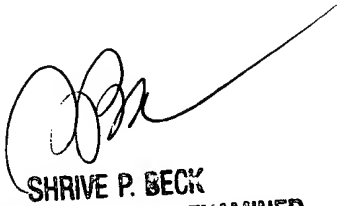
15 Any inquiry concerning this communication or earlier communications from the
examiner should be directed to William P. Fletcher III whose telephone number is (703) 308-
7956. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the
20 organization where this application or proceeding is assigned are (703) 872-9310 for regular
communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William Phillip Fletcher III
Patent Examiner
United States Patent & Trademark Office
Group Art Unit 1762

5 *wpf*
June 9, 2003



SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700